



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

SW

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,893	11/28/2001	Harunobu Kusumoto	Q67476	8024

21254 7590 12/02/2004

MCGINN & GIBB, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,893

Applicant(s)

KUSUMOTO, HARUNOBU

Examiner

Sebastiano Passaniti

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 16-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 16-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3711

DETAILED ACTION

This Office action is responsive to communication received 07/30/2004 –
Amendment.

Claims 1-12 and 16-28 remain pending.

Following is an action on the MERITS:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 and 16-28 STAND rejected under 35 U.S.C. 103(a) as being
unpatentable over Noble in view of Beach, Thorne, Sasamoto and Kosmatka, as set
forth in the last Office action, mailed 04/06/2004.

Claims 1-11, 16-22 and 24-28 STAND rejected under 35 U.S.C. 103(a) as being
unpatentable over Noble in view of Kosmatka, as set forth in the last Office action,
mailed 04/06/2004.

Claims 12 and 23 STAND rejected under 35 U.S.C. 103(a) as being
unpatentable over Noble in view of Kosmatka and Sasamoto, as set forth in the last
Office action, mailed 04/06/2004.

The prior art made of record and not relied upon is considered pertinent to
applicant's disclosure. Note Figures 1A, 1B and 9-12 in Helmstetter.

RESPONSE TO ARGUMENTS

Applicant's arguments received 07/30/2004 have been considered and are incorporated herein by reference. A complete exposition of these arguments by the applicant will not be presented here, for brevity. In summary, the applicant (1) presents numerous arguments directed towards the combination of prior art references, noting that the presently amended claims, with the inclusion of the language, "said thin-walled portion being formed around said flat surface" (claim 1) along with the language "said peripheral edge portion being formed around said flat surface" (claim 16) and "wherein said reverse surface comprises a flat surface at said first portion, said second portion being formed around said flat surface" (claim 28) define over the prior art references; (2) alleges that a prima facie case of obviousness has not been established, given that no less than five references have been used in combination to reject some of the claims; (3) argues that impermissible hindsight has been used to combine the references and that the references applied in combination, namely Noble, Beach, Thorne, Sasamoto and Kosmatka, are completely unrelated to one another; (4) indicates that the applied references fail to specifically teach any reasons for combining the respective teachings of each device; and (5) indicates that a discrepancy exists regarding the application of the combination of prior art references to Noble and Kosmatka, indicating that the Noble reference is being viewed in a manner that contradicts the manner in which Noble is applied in combination with Beach, Thorne, Sasamoto and Kosmatka.

In response to these arguments and with respect to item (1) above, note that Noble (Figures 9 and 10) may be deemed to show a flat surface surrounded by a thin

Art Unit: 3711

walled surface or peripheral edge, as broadly as claimed. Even if one were to argue that Noble does not show a flat surface, the inclusion of this feature is obviated by the prior art teaching to Kosmatka. With respect to item (2) above, it is well established in the Patent laws that "the number of references does not have a bearing on the propriety of the rejection; theoretically such could be infinite" Ex parte Fine, 1927 C.D. 84 (1926).

As to item (3) above, the references applied are indeed related, that is, all of the references are directed to hollow metal wood-type club heads. As to item (4) above, the references themselves do not necessarily need to expressly state the changes or alleged improvements that the applicant has made. All that is required to show obviousness is that the applicant "makes his claimed invention merely by applying knowledge clearly present in the art". See In re Sheckler, 168 USPQ 716 (CCPA 1971). Note additionally, Section §103 requires the presumption of full knowledge by the inventor of all the prior art in his field of endeavor (emphasis added). See In re Winslow, 53 CCPA 1574, 1578, 365 F.2d 1017, 1020, 151 USPQ 48, 50-51 (1966).

Here, all hollow metal wood-type club heads belong in the same field of endeavor as the applicant's claimed invention. As to item (5) above, the reasons for applying Noble with two varying interpretations is quite clear from the rejections themselves. Briefly, one may argue that Noble discloses a flat surface portion opposite the striking face portion. Thus, the rejection of the claims based upon Noble, Beach, Thorne, Sasamoto and Kosmatka is appropriate. Given an alternate interpretation, it may be argued that Noble lacks a flat surface, as claimed, and as such is modified by the teachings of Kosmatka.

Art Unit: 3711

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Passaniti/sp
November 27, 2004